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Masataka Ozeki

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EXAMINER

WANG, EUGENIA

ART UNIT

PAPER NUMBER

1795

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/500,274	OZEKI ET AL.	
	Examiner	Art Unit	
	EUGENIA WANG	1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-11 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 10-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In response to the amendment received January 22, 2009:
 - a. Claims 1 and 2 have been cancelled as per Applicant's request. Claim 14 has been added. Claims 3-11 and 14 are pending with claims 10 and 11 withdrawn as being drawn to unelected inventions.
 - b. The previous 112 rejection has been withdrawn in light of the amendment.
 - c. The previously applied prior art is applied in a slightly different manner, as necessitated by the amendment. All changes made to the rejection are necessitated by the amendment, thus the action is final.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4-9 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 has inconsistencies within the claim language. It is stated that "the electric power generation instructing means are configured to execute at least one of (a)... and (b)" (lines 13-19). It is noted that only the limitation denoted by part (b) has "a second threshold value" (line 18). However lines 22-23 recite "the second threshold value" without making it clear as to which power limitation mode ((a) or (b)) is being referred to (wherein the claim only requires one of the executions to be present). Accordingly, "the second threshold value" as applied to

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the first power limitation mode (a) would be indefinite, as there would not be proper antecedent basis for such a value. It is noted that such problem is also directly present within claims 4, 6, and 8 (as modes and threshold values are defined) without them being necessarily present within the claim they are dependent on (claim 14). Since claims 4-9 are dependent on claim 14 and do not rectify the issue, they are rejected for the same reason.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 3-9 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/92050 (Yamanashi) as evidenced by US 5989739 (Zur Megede et al.).

As to claims 3 and 14, Yamanashi teaches a fuel cell system that generates electricity via hydrogen gas (generated from methanol) (fuel) and oxygen gas (oxidizer) (p8, lines 9-15). There is a fuel reform reactor [120] (fuel processor) that produces the fuel to be supplied to the fuel cell from the fuel (via fuel injector [145]) (fig. 1). Combustor [140] (combustion device) combusts residual fuel gas that was unconsumed in the fuel cell (seen in fig. 1). This action raises the temperature of the reactor (reform reactor [120]), since the exhaust gas (heated from the combustor) is ultimately delivered to the reform reactor [120] (fuel processor). Furthermore, the power manager [210] takes the electricity generated from the fuel cell stack [200] and delivers it to a motor (p 8, lines 24-28). The power manager [210] in conjunction with controller [300] acts as an electric power generation instructing means, as it (the power manager [210]) delivers

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the needed power via the fuel cell and a secondary battery to the motor, and thus inherently determines how much electric power is generated by the fuel cell in order to determine how much electricity is needed from the secondary battery to deliver to the motor (load), wherein the power manager is controlled by the controller [300]. Yamanashi's fuel cell system has power manager [210], temperature sensor [122] of the reform reactor [120] (fuel processor), as well several of injectors [145, 151, 152] and flow rate valves [121, 141, 131] connected a control unit [300], as indicated by the dashed lines. The control of the fuel, water, and air flow rates would controls how much reactant is delivered to the fuel cell, and thus the rate at which power is generated and supplied.

It is further noted that Yamanashi's invention is drawn towards the prevention of fuel from being excessively used during a low-load driving state, wherein the fuel is provided by the reforming system, wherein the fuel is provided to the reformer to maintain the temperature of the reformer (p 4, lines 9-23; p6, lines 26-35).

Note: The lowering of fuel provided to the reforming system with respect to a decrease in load demand (as taught by Yamanashi) inherently decreases the power generated by the fuel cell.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

In the case of the instant application the basis for expectation of inherency is that the current (power) supplied by fuel cell is proportional to how much fuel is supplied. The more fuel supplied, the more electricity (current, power) can be generated by the fuel cell. The less amount of fuel supplied to the system (even via reformer), the less electricity that is generated. Zur Megede et al. is relied upon as an evidentiary piece to show that such a relationship is true (see col. 2, lines 30-46). Accordingly, decreasing the amount of fuel provided to the reformer would reduce the amount provided to the fuel cell, thus resulting in a lower amount of energy generated.

The Examiner requires applicant to provide that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product.

Whether the rejection is based on inherency’ under 35 U.S.C. 102, on prima facie obviousness’ under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596

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(CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

Therefore, the system of Yamanashi is capable of operating (and is thus configured to act) in such a manner the electric power generation instructing means either (1) decreases the electric power generated by the fuel cell in response to a decrease of load power to be supplied by the fuel cell and decreases the electric power generated by the fuel cell at a rate depending on a change of the temperature of the fuel processor, wherein the electric power generation instructing means are configured to decrease the generated electric power at a first rate within a predetermined first limit while the temperature of the fuel processor is rising and at a second rate having no predetermined limit while the temperature of the fuel processor is not rising (as applied to claim 3) or (2) decreases the electric power generated by the fuel cell in response to a decrease of load power to be supplied by the fuel cell and decreases the electric power generated by the fuel cell at a rate depending on a temperature of the fuel processor, wherein the electric power generation instructing means are configured to execute at least one of (a) a first power limitation mode of preventing the decrease of generated electric power within the temperature of the fuel processor is not lower than a first threshold and (b) a second power limitation mode of decreasing the generated electric power at a rate having a predetermined upper limit when the temperature of the fuel processor is not higher than a second threshold value which is lower than the first threshold value, and the electric generation instructing means are configured to decrease the generated electric power at an unlimited rate when the temperature of the

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fuel processor is not higher than a third threshold value which is lower than the second threshold value (as applied to claim 14).

It has been held that the recitation of an element is “capable” of performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

While intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). See also MPEP § 2114.

The manner of operating the device does not differentiate an apparatus claim from the prior art. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Note: The power manager [210] works in conjunction with controller [300] (as well as all of the injectors, flow rate valves, and sensors, as seen in fig. 1) in order to provide the structure configured to perform the claimed functions.

As to claim 4, Yamanashi's fuel cell system with power manager [210], temperature sensor [122] of the reform reactor [120] (fuel processor), as well several of injectors [145, 151, 152] and flow rate valves [121, 141, 131] connected a control unit [300], as indicated by the dashed lines as seen in fig. 1 is capable of operating (and thus is configured to operate in a manner) where the electric power generation instructing means (1) executes a first power limitation mode of preventing the decrease of generated electric power is executed when the temperature of said fuel processor is not lower than a first threshold value and (2) decreases the generated electric power at a rate having no predetermined limit when the temperature of the fuel cell processor is not higher than a third threshold value. For the Office's position on "capable of" for apparatus claims, please refer to the rejection of claims 3 and 14.

As to claim 5, Yamanashi's fuel cell system with power manager [210], temperature sensor [122] of the reform reactor [120] (fuel processor), as well several of injectors [145, 151, 152] and flow rate valves [121, 141, 131] connected a control unit [300], as indicated by the dashed lines is capable of operating (and thus is configured to operate) in a manner wherein the electric power generation instructing means releases the first power limitation mode when the electric power generation instructing means maintains or beings to raise the electric power generated by said fuel cell. For the

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Office's position on "capable of" for apparatus claims, please refer to the rejection of claims 3 and 14.

As to claim 6, Yamanashi's fuel cell system with power manager [210], temperature sensor [122] of the reform reactor [120] (fuel processor), as well several of injectors [145, 151, 152] and flow rate valves [121, 141, 131] connected a control unit [300], as indicated by the dashed lines is capable of operating (and thus is configured to operate in a manner) such that the electric power generation instruction means (1) executes a second power limitation mode of decreasing the generated electric power at a rate with a predetermined upper limit when the temperature of the fuel processor is not lower than a second threshold value, and (2) decreases the generated electric power at a rate that is not limited when the temperature of the fuel processor is not higher than a third threshold. For the Office's position on "capable of" for apparatus claims, please refer to the rejection of claims 3 and 14.

As to claim 7, Yamanashi's fuel cell system with power manager [210], temperature sensor [122] of the reform reactor [120] (fuel processor), as well several of injectors [145, 151, 152] and flow rate valves [121, 141, 131] connected a control unit [300], as indicated by the dashed lines is capable of operating (and thus is configured to operate) in a manner wherein the electric power generation instructing means releases the second power limitation mode when the electric power generation instructing means maintains or begins to raise the electric power generated by said fuel cell. For the Office's position on "capable of" for apparatus claims, please refer to the rejection of claims 3 and 14.

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As to claim 8, Yamanashi's fuel cell system with power manager [210], temperature sensor [122] of the reform reactor [120] (fuel processor), as well several of injectors [145, 151, 152] and flow rate valves [121, 141, 131] connected a control unit [300], as indicated by the dashed lines is capable operating (and thus is configured to operate in a manner) such that the electric power generation instructing means executes (i) a first power limitation mode of preventing the decrease of generated electric power when the temperature of said fuel processor is not lower than the first threshold value and (ii) a second power limitation mode of decreasing the generated electric power at a rate with a predetermined upper limit when the temperature of said fuel processor is not higher than the second threshold value, wherein the electric generation instructing means are configured to decrease the generated electric power at an unlimited rate when the temperature of the fuel processor is not higher than the third threshold. For the Office's position on "capable of" for apparatus claims, please refer to the rejection of claims 3 and 14.

As to claim 9, Yamanashi's fuel cell system with power manager [210], temperature sensor [122] of the reform reactor [120] (fuel processor), as well several of injectors [145, 151, 152] and flow rate valves [121, 141, 131] connected a control unit [300], as indicated by the dashed lines is capable of operating (and thus is configured to operate in a manner) such that the electric power generation instructing means releases both the first and second power limitation modes when said electric power generation instructing means maintains or begins to raise the electric power generated by said fuel

cell. For the Office's position on "capable of" for apparatus claims, please refer to the rejection of claims 3 and 14.

Response to Arguments

4. Applicant's arguments filed January 22, 2009 have been fully considered but they are not persuasive.

1. *Yamanashi does not disclose the configuration of the "electric power generation means" recited in claim 3*

Applicant argues that the algorithms disclosed in the Specification is what configures the instructing means.

Examiner respectfully disagrees. First it is noted that Applicant is applying too narrow of a definition to "configured to" language. Yamanashi et al. is configured to perform all of the same functions as that of the claimed invention because the fuel cell system of Yamanashi et al. has all of the same structural elements of the claimed invention connected in the same manner. Accordingly, it is configured to perform the same actions as it is structurally the same. Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Also, limitations appearing in the specification but not recited in the claim are not read into the claim. See *In re Zletz*, 893F.2d 319, 321-22, 13 USPQ2d, 1320, 1322 (Fed. Cir. 1989). It is further noted that Applicant has not provided any argument or proof as to how the apparatus of Yamanashi et al. is physically different from that of the claimed invention. Examiner would like to reiterate the fact that in an apparatus case, the structure of the

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apparatus must be different, not the function. It is unclear how an electric power generation instructing means (controller [300] in conjunction with power manager [210]) which operates in a certain manner differentiates the structure, when the prior art includes all of the parts of the claimed fuel cell system connected in the same manner. Examiner is unsure how a fuel cell system with all the same elements connected in the same fashion would not be configured to perform the same function. Therefore, the rejection is maintained.

Applicant argues that Yamanashi does not describe (a) decreasing generated electric power at a first rate within a predetermined first limit while the temperature of the fuel processor is rising and (b) at a second rate having no predetermined limit while the temperature of the fuel cell is not rising.

Examiner respectfully disagrees with Applicant's position. As set forth within the rejection, such limitations are *functional* limitations and thus do not further define the structure of the controller. As set forth above and within the rejection, the structure of Yamanashi et al. (the controller as connected to all of the items as shown by the dashed lines of in fig. 1) would be capable of performing the functions, as it is structurally the same as that of the claimed invention. Examiner would like to reiterate the fact that in an apparatus case, the structure of the apparatus must be different, not the function. It is unclear how an electric power generation instructing means (controller [300] in conjunction with power manager [210]) which operates in a certain manner differentiates the structure, when the prior art includes all of the parts of the claimed fuel cell system connected in the same manner. (Please see the rejection of claims 3 and

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14 for the Office's policy on apparatuses "capable of" operating in the same manner.) Examiner is unsure how a fuel cell system with all the same elements connected in the same fashion would not be configured to perform the same function. Therefore, the rejection is maintained.

Applicant argues that Nomura's temperature detecting means is installed downstream of the reforming device (specifically after it has been cooled by heat exchanger [7]) and thus does not detect the temperature of the fuel processor.

Examiner submits that such an argument is irrelevant, as Nomura et al. are no longer being relied upon (in light of the amendments to the claims changing the scope of the claims). However, Examiner would like to clarify the previously applied rejection. It is noted that Nomura et al.'s temperature sensor [24] was not being relied upon to be in the fuel processor. It is noted that Nomura et al. was used in combination with Yamanashi's temperature sensor [122] is in the fuel processor (reform reactor [120]). Nomura et al. was relied upon as to why one of ordinary skill in the art would have found it obvious to use temperature, as related to a processor, as an indication of how much fuel is in the process and to adjust the supply accordingly. Such an argument does not address the combination, and thus would not be convincing (even if the combination was still relied upon in this action).

Applicant argues that Zur Megede and Keskula do not cure the deficiencies of Yamanashi and Nomura.

Examiner submits that such an argument is irrelevant, Keskula et al. are no longer being relied upon (in light of the amendments to the claims changing the scope

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of the claims). Furthermore, it is noted Zur Megede is merely used as an evidentiary piece, and thus is not relied on to teach a deficiency.

2. *The functionality performed by the "electric power generation instructing means" is not performed by a human*

Applicant argues that a device is disclosed (in fig. 1) and that one of ordinary skill in the art would recognize that a person is not part of a device.

Examiner respectfully disagrees with Applicant's position and submits that such an argument is not applicable to the rejection at hand. It was provided with respect to claim language that is no longer present (being programmed with software instruction), and is thus irrelevant. However, Examiner would like to reiterate the position (as originally applied to the "programmed with software instructions" limitation). This was not applied as a prior art rejection but merely as a broad (non-limiting) example as how the original disclosure did not have support for a computer processor, program, or software, as such actions *could* be performed by a human (not that they *are*). Accordingly, Examiner submits that Applicant is misconstruing Examiner's 112 Rejection as set forth in the action dated September 24, 2008, as it was merely used as an exemplification as to how Applicant's original disclosure had not differentiated the instructing means beyond that of a general controller/computer.

Applicant points to the preamble, specifically pointing out that a device is claimed, and that a person is not part of a device (relying on *In re Bernhardt*, 417 F.2d 1395 (C.C.P.A. 1969) to support such interpretation).

Examiner respectfully disagrees with Applicant's position and submits that such an argument is not applicable to the rejection at hand. It was provided with respect to claim language that is no longer present (being programmed with software instruction), and is thus irrelevant. Furthermore, Examiner submits that the fact pattern of such a case is not in line with whether or not a person is part of a device (for example, it does not deal with an instructing means or a controller or how physical controls can be controlled with humans rather than machines). Again, Examiner would emphasize that Applicant is arguing thing that are no longer applicable (as the "programmed with software instructions" limitation has been removed). It is noted that nowhere did Examiner submit that a person was operating different valves in Applicant's disclosure but merely used it as a broad (non-limiting) example as how the original disclosure did not have support for a computer processor, program, or software, as such actions *could* be performed by a human (not that they *are*). Accordingly, Examiner submits that Applicant is misconstruing Examiner's 112 Rejection as set forth in the action dated September 24, 2008, as it was merely used as an exemplification as to how Applicant's original disclosure had not differentiated the instructing means beyond that of a general controller/computer.

3. *The claims do not merely recite an intended use of the "electric power generation instructing means"*

Applicant argues that the recitation of "configured to" is different from the "configure for" language and provides a structural different over Yamanashi.

Examiner respectfully disagrees (that “configured to” provides a structural difference of Yamanashi). Again, Examiner submits that Applicant is applying too narrow of a definition to “configured to” language. Yamanashi et al. is configured to perform all of the same functions as that of the claimed invention because the fuel cell system of Yamanashi et al. has all of the same structural elements of the claimed invention connected in the same manner. Accordingly, it is configured to perform the same actions as it is structurally the same. Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Also, limitations appearing in the specification but not recited in the claim are not read into the claim. See *In re Zletz*, 893F.2d 319, 321-22, 13 USPQ2d, 1320, 1322 (Fed. Cir. 1989). It is further noted that Applicant has not provided any argument or proof as to how the apparatus of Yamanashi et al. is physically different from that of the claimed invention. Examiner would like to reiterate the fact that in an apparatus case, the structure of the apparatus must be different, not the function. It is unclear how an electric power generation instructing means (controller [300] in conjunction with power manager [210]) which operates in a certain manner differentiates the structure, when the prior art includes all of the parts of the claimed fuel cell system connected in the same manner. Please see the rejection of claims 3 and 14 for the Office’s policy on apparatuses “capable of” operating in the same manner. Therefore, the rejection is maintained.

Applicant provides a dictionary definition for “configure,” wherein the definition is “to design or adapt to form a specific configuration or for some specific purpose” a

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"configuration, wherein the definition is "the relative disposition or arrangement of parts or elements of a thing" and that such definition shows that "configure" and "configuration" do not evoke intended use but a structural relationship.

Examiner respectfully disagrees and submits that Applicant's provided definitions support the rejection. Examiner would like to clarify such a position. Configure, as set forth by Applicant has an applicable definition as shown: "to design or adapt to form a specific configuration." (It is noted that the definition provided does not limit to the "for a specific purpose" definition.) Again, the word configuration is looked at, wherein it states a "disposition or arrangement of parts or elements of a thing" and further (not quoted by Applicant) goes to define that such a configuration is applied to an "external form." Accordingly, Examiner sets forth that configure and configuration can be applied as to the external aspects of a system (i.e. the connection of the controller to the external aspects that it controls or receives data from). Nowhere in the definitions does it set forth that functions/actions necessarily define the configuration of something. Accordingly, Examiner submits that the structure of Yamanashi meets the structural limitations of the electric power generation instructing means. Applicant has not provided any argument or proof as to how the apparatus of Yamanashi et al. is physically different from that of the claimed invention. Examiner would like to reiterate the fact that in an apparatus case, the structure of the apparatus must be different, not the function. It is unclear how an electric power generation instructing means (controller [300] in conjunction with power manager [210]) which operates in a certain manner differentiates the structure, when the prior art includes all of the parts of the claimed fuel

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cell system connected in the same manner. Please see the rejection of claims 3 and 14 for the Office's policy on apparatuses "capable of" operating in the same manner. Therefore, the rejection is maintained.

Applicant argues that the claim language "configured to" as applied to the "electric power generation instructing means" recite a structure (and that the control unit of Yamanashi does not have the structure).

Examiner respectfully disagrees. As set forth in the rejection and in the response to arguments and reiterated herein, "configured to" as applied used by Applicant is merely used to recite functions of an electric power generation instructing means, wherein such functions do not further define the structure of Applicant's invention. Accordingly, Yamanashi (as set forth to have the controller connected to the power manager, injectors, valves, and sensors), does have the same structure of the claimed invention and is capable of operating in same manner. (See the rejection to claims 3 and 14 as to how the structure is met and to the Office's policy on functional language as applied to apparatus cases.) Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Also, limitations appearing in the specification but not recited in the claim are not read into the claim. See *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d, 1320, 1322 (Fed. Cir. 1989). It is further noted that Applicant has not provided any argument or proof as to how the apparatus of Yamanashi et al. is physically different from that of the claimed invention. Examiner would like to reiterate the fact that in an apparatus case, the structure of the apparatus

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must be different, not the function. It is unclear how an electric power generation instructing means (controller [300] in conjunction with power manager [210]) which operates in a certain manner differentiates the structure, when the prior art includes all of the parts of the claimed fuel cell system connected in the same manner. Therefore, the rejection is maintained.

Applicant argues that 2173.05(g) of the MPEP states that functional language is not necessarily improper.

Examiner respectfully disagrees with Applicant's position and submits that there was no position set forth that the functional language used is improper. The position is that the functional language, as used by Applicant, does not structurally differentiate the claimed invention. See the Office's position on functional language as applied to apparatus claims (as set forth in the rejection to claims 3 and 14, see also MPEP 2114). Accordingly, Examiner submits that the argument, as applied is not applicable to the rejection of record, and thus the rejection is maintained.

Claim 14

Applicant applies the arguments with respect to claim 3 to that of claim 14.

Examiner, likewise, applies the responses to the arguments applied to claim 3 (above) to that of claim 14 for brevity's sake.

Applicant argues that since claim 14 is not taught that the claims dependent on it (claims 4-9) are not taught as well.

Examiner respectfully disagrees. As set forth the response to arguments, the limitations of claim 14 are taught (as analogous to claim 3). Accordingly, the rejections to the dependent claims (claims 4-9) are maintained as well.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugenia Wang whose telephone number is 571-272-4942. The examiner can normally be reached on 8 - 4:30 Mon. - Fri., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1795

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/E. W./

Examiner, Art Unit 1795

/PATRICK RYAN/

Supervisory Patent Examiner, Art Unit 1795